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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-526

EDWIN G. BEMIS, *Petitioner,*

v.

CHEVRON RESEARCH COMPANY,
STANDARD OIL COMPANY OF CALIFORNIA and
STANLEY O. HUTCHISON, *Respondents.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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BRIEF FOR RESPONDENTS IN OPPOSITION

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BRIEF FOR RESPONDENTS IN OPPOSITION

OPINION BELOW

The opinion of the Court of Appeals for the Ninth Circuit (Pet., A. 5-9) is reported at 599 F.2d 910.

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

QUESTION PRESENTED

Whether the statutory provisions for correcting inventorship joinder errors made innocently in patent applications provide a basis for a court award of a patent to a plaintiff who never made an application to the Commissioner of Patents but who claims nevertheless that he is entitled to the patent granted to the defendant on an application which, according to plaintiff, fraudulently named the defendant as the sole inventor when defendant knew that plaintiff was the sole inventor.

CONSTITUTIONAL PROVISION AND STATUTE INVOLVED

Although it appears that petitioner intended to include Const., art. I, § 8, cl. 8 in his appendix, it did not appear. It is reproduced in Appendix A hereto. Section 256 of Title 35, United States Code, is set forth in the Petition (Pet., A. 10-11).

STATEMENT

The complaint[1] in this case was dismissed by the district court on a motion under Rule 12(b), Fed. R. Civ. P. No attempt to amend the complaint ever was made by the petitioner.

The per curiam opinion of the United States Court of Appeals for the Ninth Circuit concluded "it is evident that the district court properly dismissed the complaint for failure to state a claim." (Pet., A. 9).

[1] The text of the complaint is printed in Appendix B hereto.

The Statement (Pet. 3,4) presented on behalf of the petitioner recites matter which is not true,[2] and it is not supported by the complaint which formed the basis of the actions taken by the courts below.[3]

Only federal question jurisdiction was asserted in the district court. According to paragraph 1 of the complaint (A. 2a), the civil action was said to arise under "the Patent Laws of the United States".

The subject matter of the complaint was United States Patent No. 3,720,264, which was granted by the Commissioner of Patents to respondent Chevron Research Company as assignee of respondent Mr. Hutchison, the individual named as sole inventor in the application for the patent.

The complaint alleged that petitioner, Mr. Bemis, (rather than respondent, Mr. Hutchison) was the actual sole inventor of the subject matter of the patent and that the several defendants had conspired to fraudulently obtain the patent naming Mr. Hutchison as inventor. The complaint did not allege that any of the

[2] Contrary to the assertion (Pet. 4) that no discovery has been taken in this case, an extensive discovery deposition of Mr. Bemis (the petitioner here) was taken. The substance of this testimony is inconsistent with recitations in Petitioner's Statement.

[3] Petitioner's complaint did not include allegations: (a) that an employment relationship existed between the petitioner and any of the respondents; or (b) that the petitioner disclosed information to any of the respondents; or (c) that the respondents did not inform the petitioner about something; or (d) that a period of waiting occurred before respondents filed the application for the patent; or (e) that the application for the patent was filed after petitioner's termination; or (f) that Mr. Hutchison was ever a supervisor of the petitioner; or (g) that the petitioner did not discover that the patent had issued until 1974.

respondents prevented Mr. Bemis from making an application to the Commissioner of Patents for the grant of a patent to Mr. Bemis. Nor was there any allegation that Mr. Bemis had been charged with infringement of the patent.

What was sought by the complaint was a judgment that would cause the patent to be changed to name petitioner Bemis as sole inventor and place Mr. Bemis in the posture of sole owner of the patent. The petitioner has made it clear that he did not wish to obtain a declaration of invalidity of the patent grant obtained from the Commissioner of Patents as a result of allegedly fraudulent acts knowingly committed by the defendants.

The claim of ownership in the patent on the part of the petitioner stemmed solely from the contention that the petitioner was "the true inventor" of the invention covered by the patent. There was no allegation that the petitioner acquired an interest by way of contract rights or by way of being a joint inventor with Mr. Hutchison of the patented invention.

In the courts below, the petitioner premised his right to relief on 35 U.S.C. § 256 (Pet., A. 10, 11) which relates to possibilities for correcting issued patents, rather than patent applications, wherein certain errors had been made without deceptive intention. The errors mentioned in section 256 are (a) characterizing a person as a joint inventor in the patent application when he did not have the legal status of joint inventor and (b) failing to name in the patent application a person who did not have the legal status of joint inventor.

The court of appeals considered in detail both the terms of section 256 and its legislative history but concluded "the inevitable conclusion is that section 256 is inapplicable, on the facts of this case, to secure to the appellant the relief he requests." *Bemis* v. *Chevron Research Company,* 599 F.2d 910, 912 (9th Cir. 1979).[4]

REASONS WHY THE PETITION SHOULD BE DENIED

This Case Does Not Involve a Federal Law Issue of Sufficient Importance to Justify Exercise of the Court's Discretionary Jurisdiction

Whatever may be the importance to the petitioner of this case, it is clear that the petitioner is not entitled, as a matter of right, to another review of his contentions. Review by this Court is discretionary and should not ordinarily be granted with respect to matters which are of limited interest except to the actual litigants.[5]

In assessing the importance of a matter, it is appropriate to consider the probable frequency with which similar questions might arise. An issue which need never arise again can hardly be said to be one which it would be important for the Court to resolve.[6]

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[4] The text of the court of appeals opinion in the Petition (Pet., A. 7) contains some apparent printing errors not believed to be material here.

[5] "[T]he Court does not sit to satisfy a scholarly interest in . . . issues. Nor does it sit for the benefit of the particular litigants. [Citations omitted]. 'Special and important reasons' imply a reach to a problem beyond the academic or the episodic." *Rice* v. *Sioux City Memorial Park Cemetery,* 349 U.S. 70, 74 (1955).

[6] *Id.* at 76, 77.

Such is the case here. Analysis will show that the expansive construction the petition has sought for 35 U.S.C. § 256 is quite unnecessary for the ordinary operation of the patent system to accomplish its legitimate social goals.

True inventors who desire to avail themselves of the benefits of the patent system can apply directly to the Commissioner of Patents for the grant of the rights they seek. There is no need for them to ask a court to give them the patent rights which the Commissioner of Patents has granted on an application made by another person who solemnly asserted he was the true inventor. Adverse claims of inventorship by two different individuals are assigned by statute [7] to the Commissioner of Patents for administrative resolution in the first instance, not the federal courts.

The point may be illustrated further by reference to the situation postulated in the complaint in this case. If the petitioner had been a true inventor entitled to the grant of a patent, he could have obtained that grant by making a timely and proper application [8] to the Commissioner of Patents. Nothing allegedly done by the respondents here would have barred such a grant. Rather, the appearance of a proper application for patent on behalf of petitioner would have caused the

[7] Sections 135(a) and (b) of Title 35, United States Code, pertain to the proceedings which Congress intended to be conducted by the Patent Office in dealing with interfering claims to patent rights on the same invention.

[8] The particulars of a carefully defined network of statutory requirements regarding the timing and content of patent applications presented to the Commissioner are provided by 35 U.S.C. §§ 101, 102, 111-115. Congress has conditioned the availability of lawful patent monopolies upon compliance with these requirements.

Commissioner to institute the type of interference proceeding Congress has selected as appropriate for dealing with conflicting inventorship claims.

There is no cause and effect relationship between an error made by one party in applying for a patent and another party's lack of ownership of a valid patent. Specifically, the acts of respondents in allegedly obtaining a patent improperly did not *cause* the petitioner to be without a patent. If petitioner really was a true inventor entitled to obtain patent rights under the law, the cause of petitioner's lack of a patent is his own failure to even apply to the Commissioner of Patents for the grant of a patent.

It should not be expected that, in the future, many inventors who are genuinely interested in obtaining the benefits of the patent system will seek, for legitimate reasons, to obtain patent rights without, as Congress obviously intended, making applications therefor to the Commissioner of Patents. That is, not many inventors should be seeking to present their requests for patent rights to the federal courts rather than to the Patent Office. Hence it is not important for this Court to study questions as to whether section 256 might in some circumstances provide a basis for sidestepping both the Patent Office and the requirements imposed by Congress upon applications made by inventors to the Commissioner of Patents.

Although section I of the argument in the Petition contains a heading which claims importance for aspects of this case, the text of that section appears to be largely a re-presentation of the arguments on the merits made in the courts below. There is no compilation of data that suggests widespread importance. Nor can

there be. The case simply does not involve a situation which has been troublesome in the past or which is likely to arise frequently in the future.

None of the Petition's Four "Questions Presented" Contains a Genuine Issue Appropriate for Review by the Court in This Case

Petitioner's Question One

No genuine issue is presented by this question.

It has been explained above that a cause and effect relationship, suggested in the petitioner's question one, between the alleged acts of the respondents and the alleged loss to the petitioner, simply does not exist.

The reference to *Kennedy* v. *Hazeltine,* 128 U.S. 677 (1888), in petitioner's question one also is incorrect. That case does not purport to interpret section 256. It was decided long prior to the enactment in the early 1950's of the statutory provision cited in petitioner's question one. Moreover, it should be noted that the opinion (Pet., A. 5-9) setting forth the appellate court decision for which review is sought by the petitioner does not even cite, much less rely upon, the case.

Petitioner's Question Two

Whatever may be the real thrust of this seemingly general question, it is vitiated by the fact that the question recites a factual hypothesis not set forth in the complaint in this case. The complaint does not allege that the plaintiff was free of deceptive intent or that he had no knowledge of the allegedly deceptive application to the Commissioner of Patents or that he avoided participation in deceptive acts.

No issue grounded upon this unpleaded factual hypothesis could be appropriate for consideration by the Court on review.

Petitioner's Question Three

The comments offered above in that portion of the discussion of question one concerning *Kennedy* v. *Hazeltine* are applicable here as well.

Further, no genuine issue is raised by the suggestion that the Constitution somehow bars interpretation of section 256 in a manner unfavorable to petitioner. There is nothing in U.S. Const., art. I, § 8, cl. 8, which requires Congress to enact legislation vesting exclusive rights in an inventor without regard to whether the inventor makes a timely and proper application to the proper authorities for the grant of a patent. Yet the petitioner's third question requires that this constitutional provision be read as if it contained such a requirement.

Petitioner's Question Four

The suggestion of a due process issue is misplaced.

Nothing in the complaint supports a contention that petitioner has been deprived of any patent property. No patent has been taken away from petitioner. He never applied for a patent on the invention of Patent No. 3,720,264 and he never owned or otherwise possessed such a patent.

The proceedings below have given the petitioner every opportunity that could be considered reasonable. He has been heard on all his contentions and both of the lower courts gave careful study to every aspect of the case properly before them. Petitioner's lack of

success in his effort to take away the Hutchison patent cannot be twisted into a legitimate contention that petitioner has been deprived of property without due process of law.

There Is No Conflict of Decisions Justifying Grant of the Petition

Although section IV of the argument in the Petition contends there is a "conflict among the circuits" which justifies the grant of the petition for certiorari, the cases cited do not reveal any conflict of appellate decisions on an issue raised by the complaint in this case.

The only appellate court decision referred to in section IV of the Petition is *Stoddard* v. *Dann,* 564 F.2d 556 (D.C. Cir. 1977). (Pet. 11, 12). It involved a situation wholly different from that presented by the present case and a statutory provision other than the one relied upon by the petitioner in the courts below.

In *Stoddard,* unlike the situation here, there were no private parties claiming adverse interests. The case involved only the power of the Commissioner of Patents to correct an inventorship designation in a situation where there was agreement among the parties not only about who had the legal status of inventor but also about the innocent character of an error which had led to an initially incorrect designation in the patent application.

The statutory provision involved in *Stoddard* was 35 U.S.C. § 116. (Pet., A. 11). Section 116 is in Chapter 11 of the patent statute [9] which pertains to the

[9] Patent Act of July 19, 1952, Pub. L. 593, 82d Cong., 2d Sess., ch. 950; 66 Stat. 792 (codified at 35 U.S.C.). Chapter 11 of the Patent Act begins with section 111.

application that must be made to the Commissioner of Patents to obtain a patent grant. Section 111 [10] begins with the requirement: "Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner" and concludes with some requirements as to the contents of patent applications. Further information about the application required to be made to the Commissioner of Patents is provided in sections 112-115 [11] and by the first two paragraphs of section 116. The last paragraph of section 116, the one involved in *Stoddard,* gives the Commissioner the power to permit, "under such terms as he prescribes," amendments of patent applications to correct certain innocently made inventorship designations errors. The holding in *Stoddard* was that the Commissioner under certain circumstances may change an inventorship designation from one person to another in a patent application filed by the true party in interest.

What the petitioner seems to value *Stoddard* for is its willingness to construe a statutory provision relating in terms to inventorship joinder matters as reaching to situations involving the substitution of a designation of one sole inventor for a previous designation of another sole inventor. Petitioner asserts that the statutory provision involved in *Stoddard* is "parallel" (Pet. 11) to the different statutory provision he relies upon in this case, and that a similar construction should be placed upon the statute of direct interest here.

Stoddard was decided after the main briefs were filed in the Court of Appeals for the Ninth Circuit, but

[10] 35 U.S.C. § 111.

[11] 35 U.S.C. §§ 112-115.

it was brought to the attention of the court through supplemental filings and much of the oral argument of the petitioner was concerned with *Stoddard.* Although the petitioner's contentions were fully presented to the court below, they were not found persuasive and no discussion of *Stoddard* was included in the opinion of the court. Nor was such a discussion necessary, for *Stoddard* expressly disclaims any intent to deal with situations of the type involved in this appeal. *Id.* at 565 n.11.

Thus, with regard to the precise situation actually presented here, there is no evidence of even a divergence of opinion between the District of Columbia Circuit and the Ninth Circuit, much less the type of conflict of decisions that might make it appropriate for this Court to accept petitioner's invitation to review this case. And, even if one assumed the existence of a divergence of views on the applicability of inventorship joinder statutes to inventorship substitution attempts, it is by no means clear that this question ever would be reached in disposing of this case.[12] The Court would not get to that question unless it at least found (1) that the statutes make it proper for the federal courts, rather than the Commissioner of Patents, to initially hear issues of the type sought to be raised here and (2) that the failure to plead a case involving error without deceptive intention was not fatal to petitioner's case.

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[12] Even in those situations which involve real conflicts among the Courts of Appeal, this Court ordinarily confines use of its discretionary jurisdiction to cases where the troublesome questions must be dealt with judicially to provide a proper adjudication. *The Monrosa* v. *Carbon Black Export, Inc.,* 359 U.S. 180, 184 (1959).

In summary, there is no conflict of appellate decision which would make this case a proper one for consideration by the Court.

CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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APPENDIX

APPENDIX A

U.S. Const., Art. I, § 8, Cl. 8

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Civil Action No. 76 810 AAH

EDWIN G. BEMIS, *Plaintiff*,

vs.

CHEVRON RESEARCH COMPANY, STANDARD OIL COMPANY OF CALIFORNIA, and STANLEY O. HUTCHISON, *Defendants*.

Complaint for Conspiracy, Fraud and Misrepresentation in Procurement of U.S. Patent 3720264 and Damages

FIRST CAUSE OF ACTION

Plaintiff complains against Defendants and for a first claim for relief alleges:

1. This action arises under the Patent Laws of the United States and this Court has jurisdiction thereof under Title 28 U.S.C. § 1338(a).

2. Plaintiff, EDWIN G. BEMIS, is a resident of Los Angeles County, State of California, having a place of residence at 1357 La Serena Drive, Brea, California.

3. Defendant, CHEVRON RESEARCH COMPANY, is a subsidiary of the STANDARD OIL COMPANY OF CALIFORNIA and has a place of business within this Judicial District.

4. Defendant, the STANDARD OIL COMPANY OF CALIFORNIA, is a California Corporation and has a place of business within this Judicial District.

5. Defendant, STANLEY O. HUTCHISON, is a resident of San Francisco, State of California, and is an employee of STANDARD OIL COMPANY OF CALIFORNIA.

6. On June 7, 1971, defendant, HUTCHISON, conspired with defendants, CHEVRON RESEARCH and STANDARD OIL to falsely and fraudulently sign an oath declaring himself the only true inventor of the METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING and assigned such invention to CHEVRON RESEARCH COMPANY which was United States Application No. 150,536.

7. On March 13, 1973, United States Patent 3,720,264, for the METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING, was issued to STANLEY O. HUTCHISON of San Francisco, California and assigned to CHEVRON RESEARCH COMPANY of San Francisco, California by the United States Patent Office.

8. On information and belief, Defendants caused divisional and foreign patent applications to be filed and foreign patents have issued based upon the false oath and Application No. 150,536.

9. Defendants and each of them know that EDWIN G. BEMIS was the true inventor of the above METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING, and by such false oath and application in violation of 35 U.S.C. 115, fraudulently procured the resultant U.S. Patent 3,720,264 and divisional patents related thereto in their own names and for their own benefit and profit.

10. The issuance of U.S. Patent 3,720,264, in the name of HUTCHISON and assigned to CHEVRON has caused plaintiff, the true inventor thereof, to lose reputation and notority in his business and income loss in excess of $75,000.00 annually.

SECOND CAUSE OF ACTION

Plaintiff complains against Defendants and for a second claim for relief alleges:

11. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereof.

11. Defendants conspired to use U.S. Patent 3,720,264, divisional patents and foreign patents derived therefrom for their own gain and profit and have so used them in their own business without payment of any compensation to plaintiff.

THIRD CAUSE OF ACTION

Plaintiff complains against Defendants and for a third claim for relief alleges:

13. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereto on information and belief.

14. Defendants conspired together to license and sell rights under U.S. Patent 3,720,264, divisional patents and foreign patents based thereon to others and have obtained compensation royalties and other unjust enrichment for themselves which monies are rightfully plaintiff's.

FOURTH CAUSE OF ACTION

Plaintiff complains against Defendants and for a fourth claim for relief alleges:

15. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereto.

16. The action of defendants and each of them in conspiring together to deprive plaintiff of rightful ownership of the invention described in U.S. Patent 3,720,264, divisional U.S. Patent and foreign Patents and improvements derived therefrom have caused plaintiff extreme emotional and mental distress which has interferred with the conduct of his business and personal affairs.

WHEREFORE, Plaintiff demands:

1. On his first claim for relief:

a. That the Court find him the only and true inventor of U.S. Patent 3,720,264, divisional and foreign patents

issued therefrom; and direct the Commissioner of Patents to issue a corrected Patent showing plaintiff as the only inventor thereof;

b. That defendants be ordered to sign all documents to transfer title to all foreign patents and patent applications based on U.S. 3,720,264 and other patents found by the court to be divisional patents thereof;

c. Plaintiff be awarded damages of $225,000.00;

2. On his second claim for relief:

a. Defendants be ordered to account to plaintiff for all of their use of Plaintiff's invention as described in U.S. Patent 3,720,264, divisional and foreign patents based thereon in their business and to pay plaintiff a reasonable royalty for such use;

3. On his third claim for relief:

a. Defendants be ordered to account for all compensation, royalties, rents, monies or other unjust enrichment received by reason of the licensing or other commercialization of U.S. Patent 3,720,264, divisional patents and foreign patents related thereto and to pay such monies with interest from the date of receipt thereof to plaintiff;

4. On his fourth claim for relief:

a. Plaintiff be awarded $100,000.00;

5. That plaintiff be awarded exemplary damages in the amount of $1,500,000.00;

6. Plaintiff be awarded reasonable attorneys fees;

7. Plaintiff be allowed his costs; and

8. Such other and further relief be granted to which plaintiff may be justly entitled.

DATED: 3-12-76

/s/ GILBERT A. THOMAS
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Attorney for Plaintiff